

REMARKS/ARGUMENTS

After the foregoing Amendment, claims 8, 13-14, 16, and 22-28 are currently pending in this application. Claims 8, 13-14, 16, and 22-23 are amended. Claims 24-28 are newly added.

Claim Rejections – 35 USC § 112

Claims 8 and 22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 8 and 22 are amended. Applicants submit that claims 8 and 22 as amended overcome these rejections. Withdrawal of the 35 U.S.C. § 112 rejections of claims 8 and 22 is respectfully requested.

Claim Rejections - 35 USC §103

Claims 8, 14, 16 and 22-23 are rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 7,149,524 to Reynolds (hereinafter “Reynolds”) in view of U.S. Patent No. 6,693,912 to Wang (hereinafter “Wang”). Applicants respectfully disagree, for at least the reasons that (1) Reynolds and Wang do not teach or suggest translation of Quality of Service (QoS) requirements at a wireless transmit/receive unit (WTRU) or an application at the WTRU *continuing the session*

. . . *using the translated QoS requirements*, as recited in independent claims 8 and 22, and (2) modifications of Reynolds and Wang to reach the subject matter of independent claims 8 and 22 would render both Reynolds and Wang unsatisfactory for their intended purposes.

I. Reynolds and Wang Do Not Teach or Suggest the Entire Subject Matter of Claims 8 or 22

To support the rejection of claims 8 and 22, the Examiner asserts the following: “Reynolds discloses a WTRU (8) configured for mapping quality of service (QoS) requirements of a first type of wireless communication system to QoS requirements of a second type of wireless communication system (col. 5, lines 50-65).” (*March 9, 2009 Office Action, page 9.*) Applicants respectfully disagree with this assertion on two grounds: (1) Reynolds does not teach translation of QoS requirements and (2) even if Reynolds arguably teaches translation of QoS requirements, Reynolds teaches that translation takes place in the network, not in a WTRU.

The Examiner asserts that mapping of QoS requirements takes place in the following excerpt of Reynolds:

“If, however, one or more handovers with better QoS are found to be possible in step 206, the best of those handovers is identified in step 210 and the best handover is tested against network policy in step 212. If network policy is

met, the selected handover is executed, step 214. If network policy is not met, it is tested in step 216 whether the call is to be treated as of a higher priority than network policy considerations, step 216, and if so, the best handover is executed in any case, step 218. If the priority level allotted to the call is not higher than the network policy considerations, it is tested in step 220 whether or not another handover with better QoS than available or predicted without handover is possible, step 220. If not, the system request is rejected, step 222. If one or more other handovers are identified as being possible in step 220, processing returns to step 210.” (*Reynolds*, column 5 lines 50-65, cited by Examiner in March 9, 2009 Office Action, page 9.)

Nowhere, including in the above excerpt, does Reynolds explicitly disclose QoS translation. This point is conceded by the Examiner, (*March 9, 2009 Office Action*, page 10), and the Applicants agree.

The Examiner states, however, that Reynolds inherently teaches translation of QoS requirements because Reynolds teaches a handover takes place without interruption and the wireless communication systems involved have different QoS requirements, leading to a conclusion that translation must take place. (*March 9, 2009 Office Action*, page 2.) Applicants respectfully submit that this conclusion does not find support in the relevant law. “[T]he fact that a claim limitation *may* be present in a reference does not establish that the reference inherently discloses that limitation.” (*Leggett & Platt, Inc. v. VUTEk, Inc.*, 537 F.3d 1349, 1356 (Fed. Cir. 2008) (*emphasis added*)). Further, it is not sufficient that an element is “probably or possibly present” in a cited reference. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Rather, it is required that the “missing descriptive

matter is necessarily present” to support a finding of inherent disclosure. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (*emphasis added*). There are a number of ways that Reynolds could accomplish handover of a session without interruption without including translation of QoS requirements as recited in claims 8 and 22. Nothing in Reynolds suggests that translation is *necessarily present*, as the methods described by Reynolds could be performed without translation. Therefore, Reynolds does not inherently disclose translation of QoS requirements as recited in claims 8 and 22. (See *Trintec*, 295 F.3d at 1295.) For at least this reason, Reynolds does not individually teach or suggest the subject matter of claims 8 and 22.

Applicants further submit that, even assuming *arguendo* that Reynolds teaches translation of QoS requirements, Reynolds teaches that such translation would take place in the network, not at a WTRU. To support the rejection of claims 8 and 22, the Examiner analogizes the WTRU to a mobile station 8 as taught by Reynolds. The Examiner then states that a number of translation-related steps take place at the mobile station 8, citing the excerpt of Reynolds (column 5 lines 50-65) which is included above. (*March 9, 2009 Office Action*, page 9.) However, the passages directly preceding and following the above-cited excerpt make it clear that the steps described in the excerpt do *not* take place in mobile station 8, but take

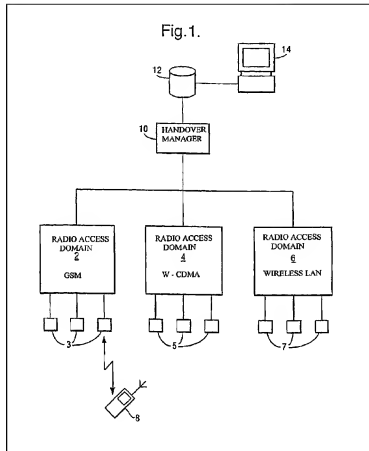
place at the handover manager 10. This is shown the following second excerpt of Reynolds, which includes materials that precede and follow the above-cited excerpt:

“Referring now to FIG. 3, the handover trigger may be received by the handover manager 10 for call maintenance reasons. . . . The handover manager 10 first identifies all handovers that meet the system request and the current minimum requirements of the user, step 202. If no handovers meet the system request and these requirements, it is nevertheless checked in step 204 whether it is possible to handover and increase the quality of service from the current or predicted low quality of service to be received without handover, step 206. . . .

[Above-cited excerpt]

. . . [T]he handover manager 10 checks that network policy is met, step 224. If network policy is met, the handover is executed, step 226.” *(Reynolds, column 5 line 34 - column 6 line 3.)*

Additional passages of Reynolds (such as, for example, column 2 line 51 – column 3 line 26) further emphasize that the data processing involved in handover is performed by the handover manager 10. Figure 1 of Reynolds clearly shows that the handover manager 10 is located in the network:



Based on the above portions of Reynolds, Reynolds does not suggest translation of QoS requirements at a WTRU. For at least this additional reason, Reynolds does not individually teach or suggest translation of QoS requirements at a WTRU as recited in claims 8 and 22.

As described above, Reynolds does not teach or suggest the translation of QoS requirements. As Reynolds does not suggest the translation of QoS requirements, Reynolds cannot suggest *an application. . . using the translated QoS requirements*

as further recited in claims 8 and 22. For at least this additional reason, Reynolds does not individually teach or suggest the subject matter of claims 8 and 22.

Wang does not teach or suggest that translation of QoS requirements should be performed at a WTRU. Wang discloses that a program for mapping QoS in a first network to QoS in a second network is transmitted (in an “active packet”) from an exit node of the first network to an entry node of the second network. When data travels from the first network into the second network via a wired connection, the program at the entry node in the second network executes the program to perform QoS translation. (*Wang, column 1, lines 56 – column 2 line 16.*) Nowhere, however, does Wang suggest that the translation should be performed at a wireless end-user node. In fact, all of the advantages of Wang rely on the translation program being executed at the network entry nodes. The translation programs can be chained across a series of networks, providing an “an end-to-end QoS guarantee” across the data path. (*Wang, column 5 lines 39-41.*) Additionally, the translation programs offer the advantage that each network “can introduce new QoS technology at its own convenience, without having to obtain the cooperation of other networks.” (*Wang, column 5 lines 32-34.*) Therefore, Wang does not teach or suggest translation of QoS requirements at a WTRU as recited in claims 8 and 22. For at least this reason, claims 8 and 22 are non-obvious over Wang individually.

As described above, Wang teaches that QoS-related processing takes place exclusively on the network. Wang additionally does not relate to the handover of a WTRU between networks, but rather relates to translation of QoS requirements as transmitted data travels across different networks. Therefore, Wang additionally does not teach an application at the WTRU *continuing the session in the second wireless communication system using the translated QoS requirements*. For at least this additional reason, Reynolds does not individually teach or suggest the subject matter of claims 8 and 22.

As described above, claims 8 and 22 are non-obvious over Reynolds and Wang individually. Further, nothing in the combination of Reynolds and Wang suggests translation of QoS requirement at a WTRU or an application at the WTRU *continuing the session . . . using the translated QoS requirements*, as recited in claims 8 and 22. Accordingly, claims 8 and 22 are non-obvious over the combination of Reynolds and Wang.

II. Modifying Reynolds and Wang Would Change Their Basic Principles of Operation

As described above, the combination of Wang and Reynolds does not teach or suggest the entire subject matter of claims 8 and 22. Further, Wang and Reynolds may not be modified to arrive at the subject matter of claims 8 and 22 because the

modifications required would change the basic principles of operation of Wang and Reynolds.

When a modification requires a change “in the basic principles” by which a reference was designed to operate, the reference is not sufficient to create a *prima facie* case of obviousness. (*In re Ratti*, 46 C.C.P.A. 976, 981 (C.C.P.A. 1959); see also *Manual of Patent Examining Procedure (MPEP)* § 2143.01.VI.) The Board of Patent Appeals and Interferences has interpreted a change in “basic principles” to mean a modification that changes “the technical basis” of how a disclosed object performs its function. (*Ex Parte Biondo et al*, *B.P.A.I Appeal 2008-4325*, page 8 (*non-precedential*).)

Independent claims 8 and 22 recite the translation of QoS requirements at a WTRU. To start at Reynolds and Wang and arrive at the translation of QoS requirements at a WTRU, a change in the basic principles of operation of both Reynolds and Wang is required. As described above, Reynolds teaches that the processing involved in handing over a WTRU is performed exclusively on the network. (*See Reynolds*, column 2 line 51 – column 3 line 26; column 5 line 34 - column 6 line 3.) To modify Reynolds by adding translation of QoS requirements at the WTRU would require a “substantial reconstruction and redesign” of Reynolds, and would be a change in the basic principles of Reynolds. (*Ratti*, 46 C.C.P.A. at 981.) Similarly, all of the advantages described by Wang flow from the fact that the

translation of QoS requirements is performed on the network. (*Wang, column 5 lines 24-52.*) Therefore, modifying Wang such that translation is performed at the WTRU would also be a change in the basic principles of Wang. For at least this additional reason, claims 8 and 22 are non-obvious over Reynolds and Wang.

III. Conclusion

For at least the reasons present above, independent claims 8 and 22 are non-obvious over Reynolds and Wang. Claims 14-16 and 23 depend upon claims 8 or 22, respectively, and are non-obvious over Reynolds and Wang at least by virtue of their dependence upon claim 8 or 22.

Claim 13 is rejected under 35 U.S.C. §103(a) as obvious over Reynolds in view of Wang, as applied to claim 9 above, and further in view of U.S. Patent No. 7,206,324 to Persson et al. (hereinafter “Persson”). As described above, Reynolds and Wang fails to render obvious independent claims 8 and 22. Additionally, Persson fails to cure the defects of Reynolds and Wang. Claim 13 is dependent upon independent claim 8, and the Applicants believe this claim is non-obvious over Reynolds, Wang, and Persson for similar reasons to those presented above.

For the reasons presented above, withdrawal of the 35 U.S.C. §103 rejection of claims 8, 13, 14, 16, 22 and 23 is respectfully requested.

Newly Added Claims

Claims 24-29 are newly added. Claims 24-25 depend upon claim 22 and are allowable over Reynolds, Wang, and Persson at least by virtue of their dependence upon claim 22. Claim 26 recites translating QoS requirements at a WTRU. This element, as described above, is not suggested by Reynolds, Wang, and Persson. Claim 26 additionally recites *a wireless interface configured to receive the translated QoS requirements and to communicate with a wireless network according to the second wireless communications standard*. These elements are additionally not taught or suggested by Reynolds, Wang, and Persson. For at least these reasons, claims 26 (as well as its dependent claims 27-28) are novel and non-obvious over Reynolds, Wang, and Persson.

Applicant: Hunkeler et al.
Application No.: 10/679,804

Conclusion

If the Examiner believes that any additional minor formal matters need to be addressed in order to place this application in condition for allowance, or that a telephonic interview will help to materially advance the prosecution of this application, the Examiner is invited to contact the undersigned by telephone at the Examiner's convenience.

In view of the foregoing amendment and remarks, Applicants respectfully submit that the present application is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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Enclosure